

the PTO has allowed perhaps hundreds of dependent claims in the "computer-readable medium" format. Further, MPEP §2173.05(f) states that a rejection under 35 U.S.C. §112 is not proper for a claim that makes reference to a preceding claim so as to define a limitation. The MPEP specifically states that an acceptable claim format is "the product produced by the method of claim 1" or "a method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions. . . ." The Applicant thus submits that the "computer-related medium" claims also are allowable under this rationale.

Paragraph 2: 35 U.S.C. § 102:

Claim 1-57 and 59-66 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,649,114 to Deaton, et al. The Applicant continues to traverse the rejection.

In response to the previous Office Action, the Applicant pointed out that Deaton simply does not show each and every element of the claims as required for an anticipation rejection under 35 U.S.C. §102(b). Specifically, Deaton's disclosure of "purchasing data" does not read on the "representative activity of the predetermined type of consumer" limitation, *i.e.*, "data" is not a "use". Although Deaton describes tracking the type of items purchased by a consumer, there is no mention of determining the uses of any type of product by a consumer during one or more representative activities. Deaton is completely silent on what a consumer does with a product during any such activity. In fact, the only activity described in Deaton is purchasing or shopping. The mere fact that a particular consumer purchases coffee does not provide any information on the activities the user *maybe* engaged in during the time the user is using, or "drinking", the coffee. Further, Deaton does not promote using anything during

shopping. Rather, the point of Deaton is to encourage the consumer to return to the store by offering various types of coupons based on what the consumer bought in the past.

The Applicant also requested that the Examiner provide references in Deaton as to a disclosure of a consumer using an item during an activity, as opposed to just tracking purchase history data. Deaton appears to be silent on how a consumer uses a product and also silent on then promoting the use of the product in the context of an activity. The Examiner, however, declined to do so. Rather, the Examiner stated that the limitations are inherently supported in the art or implicitly disclosed in the cited reference: “[f]or [e]xample, the customer can drink his coffee, subsequent to making the coffee, while he is watching TV, taking a break, talking to friends and so on and so forth.” Office Action at page 3.

The Applicant acknowledges the Examiner’s argument that the customer can drink his coffee or use a product at any time he so chooses. The Applicant submits, however, that the fact a consumer will at some point use a product after purchase is irrelevant. The mere fact that a product may be used is insufficient to anticipate the limitations of creating demand for a particular product based upon how the consumer uses that product during a specific activity. Deaton does not anticipate the claims at issue because merely tracking how often a consumer purchases a product does not have anything to do, inherently or otherwise, with the activity, use, and promotion limitations as claimed herein.

The Applicant submits that the Examiner has failed to provide a basis in fact to support the determination that the allegedly inherent characteristics necessarily flow in the teaching of the prior art. As stated in MPEP §2112, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *Id.* (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)).

(Emphasis in the original.) Specifically, the Examiner has not, and cannot, establish that Deaton shows the three elements of Claim 1: (1) determining one or more representative activities of a consumer; (2) determining one or more representative uses of an item by the consumer during the representative activities; and (3) creating demand for the item by the consumer based upon the uses of the item during the representative activities. In order to be a valid anticipation reference, the Examiner must show how these limitations are "necessarily present" in Deaton. At the very least, there can be no debate that Deaton does not show creating demand for an item based upon the uses of the item during representative activities.

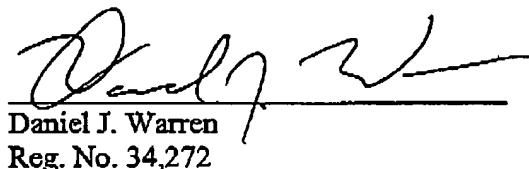
Because Deaton is only concerned with tracking consumer purchase data, no such inherency showing can be made under MPEP §2112. The Applicant thus submits that Claim 1 and the remaining claims are patentable over Deaton

The Applicant further traverses the rejection of Claims 2-57 and 59-66 for the reasons stated in the last response. The remainder of the present Office Action appears to be a verbatim copy of the previous Office Action. The Applicant thus traverses the rejections for the reason previously stated and for the reasons stated above. Specifically, there is nothing inherent in the disclosure of Deaton as to the activity, use, and promotion limitations as claimed herein.

CONCLUSION

The Applicant believes that it has responded to each matter raised in the Office Action. Any questions can be directed to the undersigned at (404) 853-8028.

Respectfully submitted,



Daniel J. Warren
Reg. No. 34,272

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, N.E.
Atlanta, Georgia 30309-3996
(404) 853-8000
djwarren@sablaw.com
Former Docket: 03628-0400
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